

Application No.: 10/617894

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**REMARKS**

Claims 1-65 are pending in the present application. Claims 23-26, 44, and 65 appear to have been examined and are rejected. Claims 1-22, 27-43, and 45-64 were withdrawn from consideration. In particular, it is noted that claim 1 was declared to be not examined, despite the fact that elected claims 23-26 and 44 all depend from claim 1. Applicant requests reconsideration and withdrawal of the present objections and rejections based on the following comments.

The Office Action has objected to claims 23-26 and 44 because these claims "depend from a nonelected claim 1." Applicant respectfully traverses this objection. It is noted that the previous restriction requirement issued by the Patent Office grouped independent claim 1 separately from dependent claims 23-26 and 44. By asserting "appropriate correction is required", it appears that the present Office Action is requiring an amending of dependent claims based on the restriction, which is certainly unorthodox and contrary to proper restriction practice. Although it is known that dependent claims can be categorized as distinct *species* apart from a *generic* independent claim from which they depend, this was not the case in the present application<sup>1</sup>. Rather, a restriction requirement was issued grouping dependent claims apart from the independent claims (i.e., Group II). Thus, Applicant respectfully submits that the restriction requirement was faulty and that Groups I and II were not actually properly classifiable in separate classes (or at least separate groupings for a restriction requirement) because they were not distinct inventions *as claimed* (See MPEP §806). Nonetheless, Applicants were required to elect a group, albeit a faulty group, established by the Examiner in the restriction issued June 15, 2005 in order to be responsive to that restriction. Applicants thus elected Group II (which did not include an independent claim) with traverse. Because it is axiomatic that a dependent claim includes the elements of the independent claim from which it depends and any intervening claims, the Office should have examined claim 1 also. To require an Applicant to amend a claim due to a restriction requirement is contrary to established Patent Office practice and prejudicial to the Applicant by *de facto* not allowing an original presentation of claims. Accordingly, Applicants remaining remarks will presume that the elements of claim 1 were indeed considered

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<sup>1</sup> Nonetheless, it is noted that Examiners are required to examine the independent generic claims when an election of species is required.

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by the Examiner in making the rejections presented in the present Office Action, as it appears did in fact occur. Moreover, claim 1 should at least be considered as part of the considered claims. Finally, Applicants submit that Groups I and II actually should have been part of a single group including claims 1-44 for a proper restriction requirement since they were not distinct *as claimed*.

### Rejections

Claims 23-26, 44, and 65 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,797,361. Applicants respectfully traverse this rejection for the following reasons.

The cited reference does not teach or suggest a “polymer article provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that, when the pressure is removed, the desired shape is produced in the deformed area” as featured in claims 23-26 and 44, since these claims include the features of independent claim 1 recited above. Similarly with respect to independent claim 65, the cited reference does not teach or suggest “[a]n elongate foam strip” featuring “a surface pattern provided in an area that has been formed to a desired shape under pressure.” Neither claims 1-24 nor Figures 1 and 2 of the cited reference disclose a surface pattern formed by applying pressure to a surface of the article. Accordingly, claims 1, 23-26, 44 and 65 are allowable over the cited reference and the rejection should be withdrawn.

Claim 23-26, 44, and 65 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No. 10/617,893. Applicants respectfully traverse this rejection for the following reasons.

A close reading of copending Application No. 10/617,893 reveals that the claimed subject matter of claims 1, 23-26, 44, and 65 is not disclosed or claimed in that application. Specifically, that application does not teach or suggest a “polymer article provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that, when the pressure is removed, the desired shape is produced in the deformed area” or “[a]n elongate foam strip” featuring “a surface pattern provided in an area that

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has been formed to a desired shape under pressure.” Moreover, the Office Action has not cited to any particular sections or figures of Application No. 10/617,893 that disclose these features. Accordingly, claims 1, 23-26, 44 and 65 are allowable over the cited application and the rejection should be withdrawn.

Claims 23, 24, and 26 were rejected under 35 U.S.C. §102(b) as being anticipated by Bambara et al. (U.S. Pat. No. 5,350,544). Applicants respectfully traverse this rejection for the following reasons.

The cited sections and figures of Bambara et al., asserted as teaching the features of claims 1, 23, 24, and 26 (i.e., Fig. 2 and col. 4, lines 40-42) do not actually teach the claimed features. Specifically, Bambara teaches heating a foam sheet 32 to form a heated surface area 36 on the foam sheet 32, thereby causing a slight foam post-expansion rise on the heated surface area 36. A cold metal die 38 with a design is positioned above the heated area 36 to form a foam sheet product 32 having a three-dimensional, foam-tread-wear surface 40. The post-heat expansion of the foam cells on the foam board stock 32 are then taught by Bambara to rise to fill in the cavities of the cold die 38 and to form, upon cooling, the three-dimensional, foam tread design. This is quite different from the claimed “surface pattern formed to a desired shape by deforming the area under pressure.” One is heated expansion into a mold, whereas the other is deformation to a shape by pressure. Accordingly, Applicant submits that Bambara does not teach or suggest claims 1 and 23-26 and that the rejection should be withdrawn.

Claims 23-26, 44, and 65 were rejected under 35 U.S.C. §102(b) as being anticipated by WO 99/52646 (“WO’646”). Applicants respectfully traverse this rejection for the following reasons.

The portions of WO’646 cited in the Office Action (i.e., page 4, lines 10-20, and Figs. 1-3) do not teach or suggest all of the claimed features of claims 1, 23-26, 44, and 65. In particular, the cited sections of WO’056 actually relate to forming a foam strip from a foam web through cold-welded seams 3a, 3b from by compressing the web with rotary cutters. This does not teach or suggest a “polymer article provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that, when the

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pressure is removed, the desired shape is produced in the deformed area" or "[a]n elongate foam strip" featuring "a surface pattern provided in an area that has been formed to a desired shape under pressure." Instead, WO'646 relates to cold welding to form strips. Accordingly, Applicant submits that WO'646 does not teach or suggest all of the features of claims 1, 23-26, 44 and 65 and that the rejection of these claims should be withdrawn.

Claims 23-26, 44, and 65 were further rejected under 35 U.S.C. §102(b) as being anticipated by WO 99/46056 ("WO'056"). Applicants respectfully traverse this rejection for the following reasons.

The portions of WO'056 cited in the Office Action (i.e., page 1, lines 30-33, and Figs. 1A-1B) do not teach or suggest all of the claimed features of claims 1, 23-26, 44, and 65. In particular, the cited sections of WO'056 actually relate to forming masking materials through the use of crush cutting blades 6. No teaching or suggestion is given concerning a "polymer article provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that, when the pressure is removed, the desired shape is produced in the deformed area" or "[a]n elongate foam strip" featuring "a surface pattern provided in an area that has been formed to a desired shape under pressure." Accordingly, Applicant submits that WO'056 does not teach or suggest all of the features of claims 1, 23-26, 44 and 65 and that the rejection of these claims should be withdrawn.

Claims 23-26, 44, and 65 were rejected under 35 U.S.C. §102(b) as being anticipated by Francis et al. (U.S. Patent No. 4,996,092). Applicants respectfully traverse this rejection based on the following comments.

The Office's Action asserts that Francis teaches a foam strip "having a surface pattern formed by applying pressure to the surface of the foam strip." In support of this assertion, Figures 1A and 1B are cited. A reading of the text describing these figures in Francis reveals, however, that Francis et al. is teaching cutting of a foam web 2 with a pair of rotary cutters 6, 8, not the formation of "a desired shape by deforming an area under pressure so that, when the pressure is removed, the desired shape is produced in the deformed area" or "[a]n elongate foam strip" featuring "a surface pattern provided in an area that has been formed to a desired shape

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under pressure.” Francis et al. does not teach or suggest such claimed features. Accordingly, Applicant submits that WO’056 does not teach or suggest all of the features of claims 1, 23-26, 44 and 65 and that the rejection of these claims should be withdrawn.

Claims 23-26, 44, and 65 were rejected under 35 U.S.C. §102(e) as being anticipated by Bouic (U.S. Patent No. 6,797,361). Applicants respectfully traverse this rejection based on the following comments.

In rejecting claims 23-26, 44, and 65 with Bouic, the Office Action asserts that Figure 1 and 2, col. 3, lines 50-55 and col. 5, lines 50-55 anticipate the claimed subject matter. In some of these cited portions, however, Bouic teaches only that “the foam material employed may be an open or closed cell polymeric foam that is resiliently compressible for conforming to a required shape for a given application.” (See col. 3, lines 50-53). In the context of Bouic, this teaching relates to fact that the foam has resilience to compression and, as such, can conform to different shapes, such as when cold-welding seams. (See col. 7, ll. 19-22). This teaching is not tantamount to a “polymer article provided with a surface pattern applied to an area of the article that has been formed to a desired shape by deforming the area under pressure so that, when the pressure is removed, the desired shape is produced in the deformed area” or “[a]n elongate foam strip” featuring “a surface pattern provided in an area that has been formed to a desired shape under pressure.” Bouic simply does not teach or suggest an article or foam strip with surface patterns providing in an areas formed by deformation through pressure. Accordingly, Applicant submits that Bouic does not teach or suggest all of the features of claims 1, 23-26, 44 and 65 and that the rejection of these claims should be withdrawn.

Claims 23-26, 44 and 65 were rejected under 35 U.S.C. §102(b) as being anticipated by EP 0 795 356 (EP ‘356) and alternatively under 35 U.S.C. §103(a) as obvious in light of EP 0 795 356. Applicants respectfully traverse this rejection as detailed below.

The Office Action asserts that EP ‘356 discloses or “strongly suggests” the claimed features of the rejected claims. However, although EP ‘356 discloses a sealing and covering strip 100 having a particular shape, merely because it has some shape (which could be said of almost any article in existence) does not mean that it teaches or suggests having an applied surface



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pattern. To the contrary, the tape 100 disclosed in FIG. 1 of EP '356 does not illustrates any applied surface patterns. The recesses 22, 23 equated to a "surface pattern" are simply not the equivalent. These are simply part of the shape of the strip 100 and are not the same as a surface pattern. Moreover, EP '356 does not suggest applied surface patterns, but merely discloses a particular strip shape. Accordingly, Applicants respectfully submit that EP '356 does not teach or suggest all of the elements of claims 1, 23-26, 44, and 65 and that the rejection should be withdrawn.

Conclusion

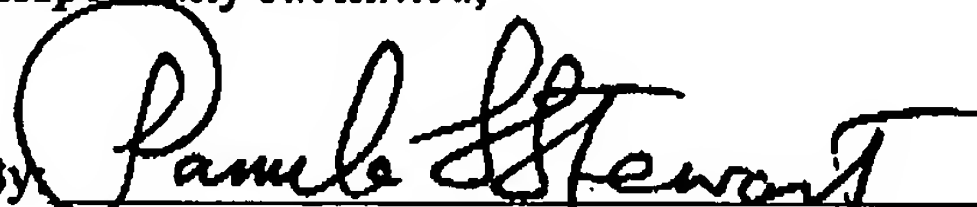
Applicant asserts that claims 23-26, 44, and 65, as well as independent claim 1 are allowable over the prior art of record. Applicant requests reconsideration in view of the remarks above and further request that a Notice of Allowability be provided. Should the Examiner have any questions, please contact the undersigned.

Respectfully submitted,

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Date

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